

## **REMARKS**

In the final Office Action,<sup>1</sup> the Examiner

- (a) objected to Applicants' claim for the benefit of priority under 35 U.S.C. § 119(e);
- (b) rejected claims 1-2 and 5-6 under 35 U.S.C. § 112, second paragraph as being indefinite;
- (c) rejected claims 24-27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2002/0046195 to Martin et al. ("Martin");
- (d) rejected claims 1-2 and 5-6 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent No. 5,019,991 to Sansone et al. ("Sansone") and further in view of U.S. Patent No. 6,005,945 to Whitehouse ("Whitehouse"); and
- (e) rejected claims 11-17 and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Sansone.

By this Amendment, Applicants have amended claims 1, 5, 11, 14, 15, 16, 17, 20, 21, 22, 24, 25, and 26, and added new claim 45. Claims 1-2, 5-8, 11-28, 30-31, and 33-45 are currently pending, with claims 7-8, 18-19, 28, 30-31, and 33-44 withdrawn from consideration. Applicants have carefully considered the pending rejections and respectfully traverse them for at least the following reasons.

### ***Priority***

In the Office Action, the Examiner stated that the "disclosure of the prior-filed application, Application No. 60/399,251, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application." Office Action, p. 2. Specifically, the Examiner contended that "the provisional application 60/399,251 fails to disclose at least the

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<sup>1</sup> The final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the final Office Action.

limitation 'digitally signing the estimated postage amount, an addressee information, a sender information, and a date; and printing the digital signature.' In fact, there is no mention of using a digital signature anywhere in the provisional application." *Id.* at pp. 2-3. Applicants disagree and note paragraph 25 of the specification, among other places. However, solely to advance prosecution, Applicants have amended the claims to delete the digital signature language. Accordingly, Applicants respectfully request that the Examiner withdraw the objection to Applicants' claims for priority.

***Claim Rejections Under 35 U.S.C. § 112, Second Paragraph***

The Examiner rejected claims 1-2 and 5-6 under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Examiner contended that, regarding claim 1, "[i]t is unclear in the printing step whether 'the postage amount' is the 'estimated postage amount.'" In response, Applicants have amended claim 1 to recite "printing the estimated postage amount" and accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

***Claim Rejections Under 35 U.S.C. § 102***

The Examiner rejected claims 24-27 under 35 U.S.C. § 102(e) as being anticipated by Martin. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131 (8th ed. 2001, 6th revision August 2007). Because Martin does not disclose each and every element recited in the claim, the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

For example, independent claim 24, as amended, recites a combination including, among other things, "printing a postage label including a postage amount represented only in an electronically readable format and a verification information used

by a mailing system to subsequently adjust the postage amount, wherein the verification information associates a sender's billing information with the mailpiece," (emphasis added). Martin does not disclose at least this element of Applicants' amended independent claim 24.

Martin generally discloses "a method for obtaining a postage stamp at a kiosk." Martin, Abstract. To this end, Martin discloses postage vendor system ("PVS") 102 is "configured to receive postage requests from kiosks 104, validate the postage requests, generate information for printing indicia in response to the postage requests, . . . , [and] communicate information for printing the indicia to the requesting kiosks 104 . . . ." *Id.* at ¶ [0041]. After kiosk 104 receives information for printing indicia from PVS 102, "[a] user may then use kiosk 104 to print the indicia using a printer device." *Id.* at ¶ [0038]. Martin further discloses that the indicia "includ[es] human-readable and machine readable portions," and that "[a]n indicium refers to the imprinted designation or postage mark used on a mail piece denoting evidence of postage payment." Martin, ¶ [0006].

As shown in Figure 4, Martin's indicia are printed stamps on a label sheet, where each stamp includes the postage amount "\$0.34" in human-readable numbers. *Id.* at ¶ [0051].

Thus, Martin does not teach or suggest "printing a postage label including a postage indicia comprising a postage amount represented only in an electronically readable format and a verification information used by a mailing system to subsequently adjust the postage amount, wherein the verification information associates a sender's billing information with the mailpiece," as recited by amended independent claim 24, because Martin discloses printing the postage amount in human-readable numbers.

See Martin, ¶ [0051]. Applicants note that all of the words in a claim “must be considered in judging the patentability of that claim against the prior art” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Here, it appears that the Examiner has impermissibly ignored the word “only” in the claim language requiring “a postage amount represented only in electronically readable format,” as recited by independent claim 24.

In addition, Martin does not teach the claimed “verification information used by a mailing system to subsequently adjust the postage amount, wherein the verification information associates a sender’s billing information with the mailpiece,” as recited by amended independent claim 24. Martin contains no information whatsoever related to a mailing system subsequently adjusting the postage amount for a mailpiece. The Office Action asserts that paragraphs 0010 and 0071 of Martin disclose this feature, but this assertion is inaccurate. Paragraph 0010 of Martin teaches about using a digital signature in the indicia to support authentication of the mailpiece. Paragraph 0071 of Martin similarly teaches generation of a digital signature using a postal security device. Elsewhere, Martin makes clear that “[t]he indicium content includes a digital signature for security reasons (to preclude forgery).” *Id.* at ¶ [0006]. Thus, neither the paragraphs cited in the Office Action, nor any other portion of Martin teaches or suggests “a verification information used by a mailing system to subsequently adjust the postage amount, wherein the verification information associates a sender’s billing information with the mailpiece,” as required by Applicants’ amended independent claim 24.

For at least the reasons above, Martin does not disclose “printing a postage label including a postage amount represented only in an electronically readable format and a

verification information used by a mailing system to subsequently adjust the mailing amount, wherein the verification information associates a sender's billing information with the mailpiece," as recited by Applicants' amended independent claim 24. Because Martin does not disclose every element of claim 24, it cannot anticipate the claim, and Applicants request the reconsideration and withdrawal of the section 102 rejection of claim 24. In addition, dependent claims 25-27 are allowable at least by reason of depending from claim 24, as well as by virtue of reciting additional features not found in the cited references.

### ***Claim Rejections Under 35 U.S.C. § 103***

#### **Regarding the Rejection of Claims 1-2 and 5-6**

Applicants respectfully traverse the rejection of claims 1-2, and 5-6 under 35 U.S.C. §103 as being obvious over Martin in view of Sansone and further in view of Whitehouse. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142. In this application, a *prima facie* case of obviousness has not been established because the Examiner has not properly ascertained the scope and content of the prior art (See M.P.E.P. § 2141), and thus, has failed to clearly articulate a reason why the prior art would render obvious the claims.

Amended independent claim 1 calls for a combination including, for example, "printing the estimated postage amount, an addressee information, a sender information, and a date on a postage indicia, the postage indicia including the estimated

postage amount in a format readable by machine only.” For the same reasons given above with respect to claim 24, the Examiner has not properly ascertained the scope and content of the cited references and Martin fails to teach or suggest at least this feature of Applicants’ amended independent claim 1.

The Examiner’s application of Sansone and Whitehouse does not cure the above-noted deficiencies of Martin, nor does the Office Action allege otherwise. More specifically, the Examiner alleged that Sansone teaches of “affixing to a mailpiece a postage indicia,” “mailing the mailpiece,” and “paying an adjusted postage amount.” Office Action, p. 9. The Examiner cited Whitehouse for its teaching of “digitally signing an addressee information, a sender information, and a date and printing the addressee information, the sender information, and the date on a postage indicia.” *Id.* at p. 10.

Even assuming the Examiner’s characterization of Sansone and Whitehouse is correct, which Applicants do not concede, neither Sansone nor Whitehouse teach or suggest “printing the estimated postage amount, an addressee information, a sender information, and a date on a postage indicia, the postage indicia including the estimated postage amount in a format readable by machine only,” as recited in claim 1. The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 1. Accordingly, the Office Action has not articulated a reason why the claims would be obvious to one of ordinary skill in the art and no *prima facie* case of obviousness has been established with respect to claim 1. Claims 2, 5, and 6 each depend from claim 1, and are allowable for at least the same reasons, as well as by virtue of reciting additional features not taught nor suggested by the cited references. Similarly, new claim 45 depends from claim 1, and is allowable for at least

the same reasons. Applicants therefore respectfully request the withdrawal of the section 103 rejection of claims 1-2, 5-6, and submit that, for at least the same reasons, the cited references, either alone or in combination do not render new claim 45 obvious.

**Regarding the Rejection of Claims 11-17**

Applicants respectfully traverse the rejection of claims 11-17 and 20-23 under 35 U.S.C. §103 as being obvious over Martin in view of Sansone. A *prima facie* case of obviousness has not been established because among other things, the Examiner has not properly ascertained the scope and content of the cited references as neither Martin nor Sansone, nor their combination, teaches or suggests each and every feature of Applicants' claims.

Amended independent claim 11 calls for a combination including, for example, "means for outputting a postage indicia comprising a stealth postage, the stealth postage comprising the estimated postage amount in a format readable by machine only." Similarly, amended independent claim 20 calls for a combination including, for example, "printing a postage label including a postage amount represented only in an electronically readable format and a verification information used by a mailing system to subsequently adjust the postage amount, wherein the verification information associates a sender's billing information with the mailpiece."

For the same reasons given above with respect to Applicants' amended independent claim 24, Applicants have already established that the Office Action misinterprets the scope and content of the cited references and that Martin fails to teach or suggest at least these elements of Applicants' amended independent claims 11 and 20. Further, Applicants have already established that the Examiner's application of

Sansone fails to cure the above-noted deficiencies of Martin. That is, the cited references, taken either alone or in any reasonable combination, fail to teach or suggest all the limitations of claims 11 and 20. Accordingly, the Office Action has not articulated a reason why the claims would be obvious to one of ordinary skill in the art and no *prima facie* case of obviousness has been established with respect to claim 11 and 20. Claims 12-17 and 21-23 depend from claims 11 and 20, respectively, and should be allowable for at least the same reasons, as well as by virtue of reciting additional features not taught nor suggested by the cited references. Accordingly, Applicants request that the section 103 rejections of claims 11-17 and 20-23 be withdrawn.

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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